

05-27-05

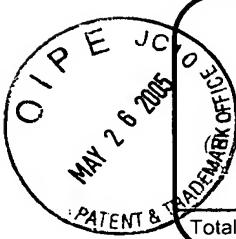
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PTO/SB/21 (08-03)

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TRANSMITTAL FORM

(be used for all correspondence after initial filing)

Total Number of Pages in This Submission

Application Number	10/613,679
Filing Date	July 3, 2003
First Named Inventor	Chris Roberts
Group Art Unit	3739
Examiner Name	Philip Robert Smith

5

Attorney Docket Number

281_390NP

ENCLOSURES (check all that apply)

- Fee Transmittal Form
- Fee Attached
- Amendment / Reply
- After Final
- Affidavits/declaration(s)
- Extension of Time Request
- Express Abandonment Request
- Information Disclosure Statement
- Certified Copy of Priority Document(s)
- Response to Missing Parts/ Incomplete Application
- Response to Missing Parts under 37 CFR 1.52 or 1.53

- Drawing(s)
- Licensing-related Papers
- Petition
- Petition to Convert to a Provisional Application
- Power of Attorney, Revocation Change of Correspondence Address
- Terminal Disclaimer
- Request for Refund
- CD, Number of CD(s)

- After Allowance Communication to Technology Center (TC)
- Appeal Communication to Board of Appeals and Interferences
- Appeal Communication to TC (Appeal Notice, Brief, Reply Brief)
- Proprietary Information
- Status Letter

Other Enclosure(s)
(please identify below):

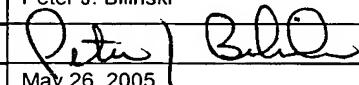
3 Page Response to Restriction Requirement and Return Mailroom Postcard

Remarks

The Commissioner is authorized to charge any additional fees to Deposit Account No. 50-0289.

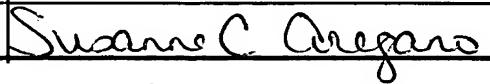
Express Mail Label No. EV 402383255 US

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm or Individual name	Wall Marjama & Bilinski LLP Peter J. Bilinski	Reg. No. 35,067
Signature		
Date	May 26, 2005	

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May 26, 2005

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Practitioner's Docket No.: 281_390NP

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Chris Roberts et al.

Ser. No.: 10/613,679

Art Unit: 3739

Filed: July 3, 2003

Examiner: Philip Robert Smith

For: MEDICAL DIAGNOSTIC INSTRUMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

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Susanne C. Aregano
Susanne C. Aregano

RESPONSE TO RESTRICTION REQUIREMENT

Sir:

In response to the Office communication having a mailing date of April 27, 2005, and pursuant to 37 CFR 1.143 and MPEP 818.03(b), Applicants hereby provisionally elect, with traverse, to prosecute the claims of Group I (Claims 1-24) in the above-captioned patent application.

Applicants respectfully traverse the pending Restriction Requirement since the subject matter, particularly of Groups I and III; that is, Claims 1-24 and 31-33, of the present invention, is sufficiently related that a thorough and complete search for the subject matter of the elected claims would necessarily encompass a thorough and complete search for the subject matter of these non-elected claims. Moreover, the Examiner has not met his burden under the Statute under MPEP 806.05(h) to define sufficient reasons, particularly as to why the product claims of Group I and the method of use claims of Group III are patentably distinct from one another to warrant restriction by the Office. The Examiner has argued that

Claims 31-33, as read, can be used in a materially different process. Applicants do not understand this argument. In the present instance, Claim 31 specifically recites a method of use for operating a medical diagnostic instrument. The Examiner, however, has remarked that this claim could be read to operate upon something other than a medical diagnostic instrument. Applicants do not understand since the claim clearly and positively recites relative movement of a contained lamp assembly of a medical diagnostic instrument. As a result, the preamble language as to the diagnostic instrument use of the method is structurally and specifically applied within the body of the claim (Claim 31) defining this group. Therefore, Applicants believe that Claim 31 cannot be read to be practiced with another materially different product, pursuant to the requirements for distinctiveness required by MPEP 806.05(h). The Examiner has not previously noted that the product as claimed can be used in a materially different process of using that product and so that prong of the distinction test is not believed to be applicable with regard to the claims. Therefore, it is believed restriction is improper under the Statute.

Applicants therefore respectfully request that Group III be included with Group I as there should be no unreasonable burden in terms of either search or examination of these claims taken in toto. See MPEP 803 et seq. in which it is clearly stated that "[i]f the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits." It is respectfully submitted that this policy should apply in the present application in order to avoid unnecessary delay and expense to Applicants and improper duplicative examination by the Patent Office.

Entry of this response and expedited examination of the elected claims is respectfully requested at this time.

If the Examiner wishes to expedite disposition of the above-captioned patent application, he is invited to contact Applicants' representative at the telephone number below.

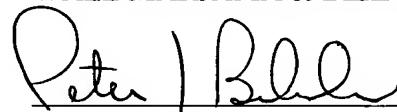
The Director is hereby authorized to charge any additional fees associated with this communication or credit any overpayment to Deposit Account No. 50-0289.

Respectfully submitted,

WALL MARJAMA & BILINSKI LLP

May 26, 2005

Date


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